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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,006	12/27/2000	Wolfgang von Deyn	47679	4682
2292	7590	05/15/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/748,006

**Applicant(s)**

DEYN ET AL.

**Examiner**

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE of 09748006 filed on 03/24, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-11,14,16 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) 22,23,33 and 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,8-11,14,16,21,35 and 36 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 24-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application claims benefit of the foreign application:  
GERMANY 19701446.1 with a filing date 01/17/1997.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 24, 2006, has been entered.
3. Amendment of claims 1-2, and cancellation of claims 5-7, 12-15, 17-20 in the amendment filed on June 6, 2005, is acknowledged. Claims 1-4, 8-11, 14, 16, and 21-36 are pending in the application.

### ***Responses to Amendment and Arguments***

4. Applicant's arguments regarding rejection of claims 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 under obviousness-type double patenting over Bratz et al. US 6,479,437, filed on June 6, 2005, have been fully considered and they are persuasive. Since the instant compounds of formula (I) do not contain a thiazole moiety, therefore, rejection of claims 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 under obviousness-type double patenting over Bratz et al. US 6,479,437, has been withdrawn.

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5. Claims 1-4,8-11,14,16,21,35 and 36 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to 3-Heterocyclyl-substituted benzoyl derivatives.

### ***Objection***

6. Claims 24-32 are objected to as containing non-elected subject matter, i.e., the variable X represent O, S, NR<sup>9</sup>, or CO, or the variable Y represents CO of claims 24-25, and 30, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 of the previous Office Action, dated March 04, 2005. Claims 22-23 and 33-34 are objected to as being non-elected inventions. Elimination of claims 22-23, and 33-34 would obviate the objection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707.

The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

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the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER

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May 11, 2006